

REMARKS

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The last Office Action has been carefully considered.

It is noted that claims 1-5 and 8-13 are rejected under 35 U.S.C. 102(e) over the patent to Menon.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) over the patent to Menon in view of the patent to Hirschenhofer.

After carefully considering the Examiner's rejection of the claims over the art, applicants have amended claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art. Also, applicants added new independent claims 14 and 15.

It is respectfully submitted that claims 1, 14, and 15 define the fuel cell device which is different from the fuel cell device disclosed in the references.

Claim 1, the broadest claim on file, specifically defines that in the inventive fuel cell device with at least two fuel cell elements, the at least two fuel cell elements are coupled electrically with one another.

Turning now to the references and in particular to the patent to Menon, et al, it can be seen that in the fuel cell system disclosed in this reference a primary fuel cell and a secondary fuel cell are provided. However, each of these fuel cells are connected with its individual electrical load. Therefore, in the fuel cell system disclosed in the patent to Menon, there is no electrical coupling between the two fuel cells. This reference therefore does not teach the new features of the present invention as defined in the amended claim 1.

The original claims were rejected over the patent to Menon as being anticipated. In connection with this, it is believed to be advisable to cite the decision in re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Menon does not disclose each and every element of the present invention as now defined in the amended claim 1.

Therefore it is respectfully submitted that the anticipation rejection of the original claims should be considered as no longer tenable with respect to claim 1 and should be withdrawn.

Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

In view of the Examiner's rejection of some claims as being obvious under 35 U.S.C. 103(a), it is respectfully submitted that the new features of the present invention as now defined in the amended claim 1 are not disclosed in the references, and the references have no hint or suggestion that these features can be provided in the references. In order to arrive at the applicant's invention from the combination of the references, the references have to be fundamentally modified by including into them the new features which are now defined in the amended claim 1.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

In claim 1 the at least two fuel cell elements are coupled with one another electrically, as disclosed for example in the specification on page 16, first paragraph.

Claim 14, which is a new independent claim, specifically defines that one of the fuel cells with higher power is operated both in the partial load region as well as in the full load region, while the second fuel cell with lower power is operated in the full load region additionally. These features are disclosed in the specification on page 9, second paragraph.

The published patent application to Menon as well as the patent to Hirschenhofer do not teach these new features of the present invention, and they can not be derived from these references as a matter of obviousness.

It is therefore believed that claim 14 should also be considered as patentably distinguishing over the art and should also be allowed.

Claim 15, which is another new independent claim, defines that in the fuel cell device of the present invention with the fuel cell unit formed to provide an operation for supplying heat, in the case of increased heat consumption of the total system, the control unit controls the smallest possible fuel cell element to produce electrical power. This is disclosed on page 12 of the specification on the last paragraph.

The features of claim 15 are also not disclosed in the references applied by the Examiner and there is no hint or suggestion in the references for these features. It is therefore respectfully submitted that neither the anticipation rejection over the published patent application to Menon, nor the obviousness rejection on based on the combination of this reference with the patent to Hirschenhofer should be considered as tenable with respect to claim 15.

Claim 15 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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